

R E M A R K S

- Claims 1-121 are pending in the present application.
- Claims 1, 24, 46, 67, 92 and 101 are independent.
- Claim 45 has been **amended** herein to correct a typographical error noted during a review of the application.

I. Telephone Interview Summary

Applicants thank Examiner for extending the courtesy of a telephone interview on November 06, 2002. Discussed during the interview was claim 1 and U.S. Patent No. 5,845,265 to Woolston (hereinafter Woolston) as applied thereto. Applicants argued that Woolston does not teach or suggest the step of:

“transmitting an offer for a second product to the first person based on the data identifying the first person.”

Examiner disagreed and pointed to col. 12, lines 55 – 56, which reads:

“If the participant has elected to ship goods then the consignment node will print a shipping label for the consignment node user to attach to the good for shipment.” (emphasis added)

Examiner took the position that this passage teaches a second product, as recited in claim 1. Applicants pointed out that this passage describes a subroutine for transferring the ownership of goods sold via the Woolston system, and that the plural of “goods” refers to any global preferences the participant may have established for the transfer of goods the participant purchases through the Woolston system, *as applied to the particular good* the ownership of which is being transferred when the subroutine is executed. Examiner was not persuaded by this argument.

Applicants also pointed out that the above passage cited by Examiner did not teach or suggest *“transmitting an offer for a second product”*, as recited in the claim. Examiner responded by stating that “transfer of ownership is synonymous with transmitting an offer.” No agreement regarding the claim was reached during the interview and Applicants are presenting arguments herein as to why Woolston does not teach or suggest the claimed invention.

II. Section 102 Rejections

Summary of Rejection

Claims 1 – 9, 11 – 32, 34 – 75, 77 – 96, 98 – 109, and 111 – 121 stand rejected under §102(e) as being anticipated by Woolston. Applicants respectfully traverse the Examiner’s §102(e) rejection. Woolston does not teach or suggest each of the limitations of the pending claims, as will be discussed in detail below.

Independent Claims 1, 24, 67, and 101

Independent claims 1, 24, 67, and 101 each recite the following (or an analogous) limitation:

“transmitting an offer for a second product to the first person based on the data identifying the first person”

Such a feature is not taught or suggested by Woolston or any other prior art of record. Woolston teaches selling a product to a purchaser. However, Woolston does not teach or suggest transmitting an offer for another, distinct, product to the purchaser. Woolston does teach keeping a record of a sale and, under certain circumstances, contacting the person that has previously purchased a product via the Woolston system to inform the person that another purchaser is interested in the previously purchased product (col. 7, lines 1 – 41). However, Woolston does not teach or suggest informing the person that previously purchased the product of another (i.e., second) product. Woolston’s teachings are limited to communications regarding the previously purchased product (analogous to the “first product” as recited in independent claims 1, 24, 67, and 101). The following example is provided for purposes of illustrating at least one difference between the Woolston system and the embodiments of Applicants’ invention encompassed by independent claims 1, 24, 67, and 101:

Example:

Assume in Woolston person A purchases product A. A record is retained of the fact that person A purchased product A. Subsequent to the purchase of product A by person A, a person B performs a search for product A in the Woolston system. Using the information in the record of the previous purchase of product A by person A, person A may be contacted or informed of person’s B’s interest in product A.

Turning now to Applicants’ claimed invention, assume again that person A purchases a product A and a record is retained of the fact that person A purchased product A. Further, assume again that subsequent to the purchase of product A by person A, a person B expresses interest in purchasing product A. In Applicants claimed invention, not only may person A be contacted (e.g., based on this expressed interest in product A by person B), but person A is offered a distinct product C (i.e. the “second product”, as recited in claims 1, 24, 67, and 101) when he is contacted. For example, product C may be offered to person A in exchange for person’s A agreement to provide product A to person B. Woolston does not teach or suggest offering person A any other product after person A purchases product A.

Applicants note that Examiner focused on the language of Woolston in column 12, lines 54 – 58, quoted above in the telephone interview summary, that refers to “goods”. The use of the plural “goods” in this passage, however, is not relevant to the claim limitation of “transmitting an offer for a second product to the first person...”. As also described in the telephone summary, the usage of the plural “goods” in Woolston merely refers to the fact that goods may be purchased during several transactions.

Further, Woolston does not teach or suggest the claimed feature of transmitting an offer for a second product to the first person (*i.e.*, the person to whom the first product was provided). In Woolston, a person that purchases a product via the Woolston system is referred to as a “participant” (col. 4, line 61). As discussed above, Woolston teaches that a participant may be contacted after he purchases a product if another person is interested in purchasing the same product the participant previously purchased. Woolston does not teach or suggest, however, that an offer for a second, distinct, product may be transmitted to the participant who previously purchased the first product. Such a feature is not described or suggested in Woolston and thus there is no teaching of how the Woolston system would determine a second product for inclusion in such an offer, much less any teaching of how to transmit an offer for such a second product.

Regarding Examiner’s statement, made during the telephone interview of November 06, 2002, that “transmitting an offer is synonymous with transferring ownership”, Applicants respectfully request that Examiner provide further clarification and support in the record for this assertion if Examiner continues to rely on this assertion. Applicants respectfully traverse Examiner’s assertion that the two activities are “synonymous,” and there is no evidence in the record to depart from the ordinary meanings of these terms.

For the reasons argued above, Applicants submit that independent claims 1, 24, 67, and 101 (and all claims dependent thereon) are patentable over Woolston and all other prior art of record and request that the §102(e) rejection thereof be withdrawn.

Independent Claim 46

Claim 46 recites the following limitation, which is not taught or suggested by Woolston or any other prior art of record:

“receiving an offer for a second product from the supplier, wherein the offer is a result of an inquiry by a second person to the supplier for the first product.”

Claim 46 recites a method in accordance with embodiments of applicants’ invention from the perspective of, e.g., a person that obtains a first product from a supplier. This first person, subsequent to obtaining the first product, receives an offer for a second, distinct product. This feature is not taught or suggested by Woolston for the same reasons argued above for claims 1, 24, 67, and 101. In other words, just as Woolston does not teach or suggest transmitting an offer for a second product to a person that previously purchased a first product, Woolston also does not teach or suggest the first person receiving such an offer. Further, Woolston does not teach or suggest the first person receiving such an offer for a second product *“as a result of an inquiry by a second person to the supplier for the first product”* (emphasis added). Accordingly, Applicants respectfully request that the rejection of claim 46 and each claim dependent thereon (claims 47 – 66) be withdrawn.

Independent Claim 92

Claim 92 recites the following limitation, which is not taught or suggested by Woolston or any other prior art of record:

“receiving an offer for the first product from the supplier, wherein the offer is a result of a search by the supplier to determine whether a second person has the first product and whether the first product is available”

Claim 92 recites a method in accordance with embodiments of applicants' invention from the perspective of a purchaser that desires to purchase a product that has been previously purchased by another purchaser. As discussed above with reference to claims 1, 24, 67, and 101, Woolston teaches allowing a purchaser to search or inquire about products that have been previously purchased by another purchaser. However, Woolston only teaches that the search results of such a search “allowing the local consignment node user to view past purchaser information” or, alternatively, “provid[ing] the Agent with an option of contacting that consignment node user so he may contact the prior purchaser.” (col. 7, lines 24 – 41).

Thus, a person in the Woolston system that is interested in a product previously purchased by a previous purchaser may view information about the previous purchase or contact the previous purchaser directly. The person in Woolston is not presented with an offer for the product previously purchased by the previous purchaser (e.g., which the person may accept and thus purchase). In Woolston, the person interested in purchasing a product previously purchased by a previous purchaser needs to negotiate the purchase of the product with the previous purchaser. In Applicants' claimed embodiments, the person is presented with an offer for the previously purchased product without needing to engage in negotiations with the previous purchaser directly.

Since Woolston does not teach the above cited step of claim 92, Applicants respectfully request that the rejection of claim 92 and all claims dependent thereon (claims 93 – 100) be withdrawn.

Dependent Claims

Claims 2 – 23, 25 – 45, 47 – 66, 68 – 91, 93 – 100, and 102 – 121 are each dependent on one of the independent claims argued above. Accordingly, they are patentable at least because they include the respective limitations of the independent claim from which they depend. Applicants respectfully request that the rejections of these claims be withdrawn for the same reasons as argued with respect to the independent claims 1, 24, 46, 67, 92, and 101.

III. Section 103(a) Rejections

Claim 10 stands rejected as being unpatentable over Woolston in view of Patent No. WO 97/23,838 to Scroggie et al. (hereinafter Scroggie). Applicants respectfully traverse Examiner's §103(a) rejection. Claim 10 is dependent from claim 1.

As discussed above, Woolston does not teach or suggest each of the limitations of claim 1 and thus claim 1 is patentable over Woolston. Scroggie also does not teach or suggest the limitation of claim 1 discussed above. In other words, Scroggie does not teach or suggest transmitting an offer for a second product to a person that has previously obtained a first product. Since claim 10 includes each of the limitations of claim 1, it is patentable at least for the same reasons as argued for claim 1.

Further, Examiner has not provided a proper motivation to combine Woolston and Scroggie. Examiner has merely stated that “*it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the system of Woolston such that it will contain important information of the contact person. This is because it would improve Woolston’s system to select the stored data from the given address.*” Stating that prior art references have been combined because the combination results in an improved invention is not a proper motivation to combine. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 706.02(j). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992).

Even if Examiner takes the position that the limitations of the pending claims are taught by various pieces of prior art, which Applicants submit they are not, Applicants urge Examiner to apply a proper obviousness analysis and point to a specific suggestion in the prior art that would make the combination of the prior art references result in Applicants’ claimed invention. A proper obviousness analysis cannot be “limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention” (*In Re Dembiczak*, 175 F.3d 994, Fed. Cir. 1999, holding that the Board of Appeals holding of obviousness cannot stand as a matter of law, due to the Board’s failure to support its finding of obviousness by a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” (*Id.*).

Accordingly, Applicants respectfully submit that Examiner has failed to establish a prima facie case of obviousness for the claim 10 and request that the §103(a) rejection of claim 10 be withdrawn.



Conclusion

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

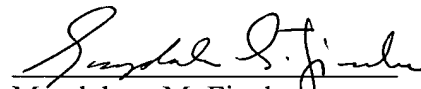
Petition for Extension of Time to Respond

Applicants hereby petition for a ~~one-month~~ extension of time with which to respond to the Office Action. Please charge \$55.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

November 12, 2002
Date


Magdalena M. Fincham
Agent for Applicants
Registration No. 46,085
mfincham@walkerdigital.com
Walker Digital, LLC
203-461-7041 / voice
203-461-7300 / fax

PATENT



Application No. 09/283,389
Attorney Docket No.: 98-099

CLAIM AMENDMENTS MARKED - UP FORM

Please **AMEND** pending claim **45** as follows:

45. (AMENDED) A [method] system as recited in claim 24, wherein the first product is more than one product.